

Kuno and further in view of IBM Technical Disclosure Bulletin, February 1992, Volume 34, Issue 9, pp. 29-32.

Claims 21-25 have been cancelled without prejudice. As a result, claims 8-20 are currently pending in the patent application.

In a teleconference on June 7, 2001 with Examiner Eisen, the pending claims and cited references were generally discussed. However, no agreement was reached. The Applicant thanks Examiner Eisen for the teleconference.

Applicant respectfully disagrees with the Examiner's 35 U.S.C. 112 rejections. With respect to the rejection of claim 8, Applicant respectfully points out that the patent application discloses that the pen-type device may provide capabilities such as "handwriting recognition" on page 1, lines 10-13. With respect to the claim 16 rejection, the support for the element "the raster image display is not capable of receiving input from a pen-type input device" can be found on page 3, lines 2-5 of the patent application, which states that, in one embodiment, "the first display 106 functions as a conventional display while the second display 110 functions as a pen-based display." As such, the second display 110, in one embodiment, is capable of receiving input from a pen-type input device "while" the first display 106 is not. Accordingly, the patent application fully supports the elements recited in claims 8 and 16.

The Examiner relies on the hypothetical combination of Lin, Harada, and Kuno in rejecting claims 8-15, and the hypothetical combination of Lin and Harada in rejecting claims 16-20. The Office Action fails to establish a *prima facie* case of obviousness, as set forth in Section 2143.01 of the Manual of Patent Examining Procedure (M.P.E.P.), which stipulates that there must be some suggestion or motivation to modify the reference or to combine reference teachings. However, it is well established that references that teach away from the invention at hand do not provide the necessary motivation to combine.

Claim 8 calls for a display module having a first and second display. The first display is adapted to display images, and the second display, which is coupled to the first display, is adapted to accept input from a pen-type input device for at least handwriting recognition, *wherein the first and second displays are adapted to be used concurrently.* [emphasis added].

In rejecting claim 8, the Examiner argues that Lin teaches all of the elements except a second display that is adapted to accept input from a pen-input device for at least handwriting recognition. The Examiner relies on Kuno to supply the missing element in order to make an obviousness rejection.

Kuno teaches using a display that is adapted to accept input from a pen-input device for handwriting recognition. Lin discloses a computer system with dual displays that are foldable at a desired tilt angle so that the displayed images can be viewed by plural persons at different locations. Column 1, lines 36-41. As shown in Figure 2, the two displays disclosed in Lin face in opposite directions.

The invention recited in claim 1, however, is directed to using the first and second displays concurrently, where the first display is used to display images and the second display to accept pen-input from a user. Figure 1 of the patent application provides an exemplary arrangement of how the two displays that may be concurrently utilized by a user.

There is no suggestion or motivation, express or implied, to combine the teachings of Lin with that of Kuno to arrive at the claimed invention. In fact, it would be counter-intuitive to combine the teachings of Lin and Kuno in the claimed manner because the two displays in Lin face in opposite directions, and therefore making one a pen-input display and the other an image viewing display would not make it conducive for concurrent use in a manner consistent with the claimed invention. As such, because there is no requisite suggestion or motivation to combine the cited references, claims 8 and its dependent claims are allowable.

Claim 16 calls for a method to use a computer system having a raster image display element and a pen-based display element. The method comprises *arranging the computer system such that the raster image display element and the pen-based display element are viewable by a user*, wherein the raster image display is not capable of receiving input from a pen-type input device. The method further includes operating the computer system by interacting with the raster image display element and the pen-based display element concurrently.

In rejecting claim 16, the Examiner argues that Lin teaches all of the elements except a second display that is adapted to accept input from a pen-input device. The Examiner relies on Harada to supply this missing element in order to make an obviousness rejection.

Lin teaches away from the invention recited in claim 16. Lin describes a notebook computer with dual displays that can be folded at a desired tilt angle such that the images thereon can be viewed simultaneously by plural persons at different positions. Column 1, lines 36-41. Thus, Lin teaches a first display that faces the computer operator and a second display that faces away from the computer operator. Lin discloses that the purpose of the second display is to allow multiple users to view the displayed contents. Column 1, 36-41. Because the second display is oriented away (see Figure 2 of Lin) from the computer operator, Lin teaches away from the claimed invention of arranging the computer such that the first display (e.g., raster image display) and the second display (e.g., pen-based display element) *are viewable by the same user*. For this reason, claim 16 and its dependent claims are allowable.

In light of the aforementioned arguments for allowability, all of the pending claims are allowable. Arguments pertaining to selected dependant claims have been noted. However, to the extent that characterizations of prior art references or Applicant's claimed subject matter are not specifically addressed, it is to be understood that Applicant does not acquiesce to such characterizations.

The Examiner is invited to contact the undersigned attorney at (713) 468-8880 with any questions, comments, or suggestions relating to the referenced patent application.

No additional fees are believed to be required due to this response. The Commissioner is authorized to charge any additional fees or credit any overpayment to Deposit Account No. 20-1504 (MICE-0029-US).

Respectfully submitted,

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